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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/733,150

12/10/2003

Chia Soo

62855.4

8266

7590

05/16/2008

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EXAMINER

EPPS FORD, JANET L

ART UNIT

PAPER NUMBER

1633

MAIL DATE

DELIVERY MODE

05/16/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/733,150	<b>Applicant(s)</b> SOO, CHIA	
	<b>Examiner</b> Janet L. Epps-Ford	<b>Art Unit</b> 1633	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above claim(s) 1-16 and 28-53 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                      |                                                                   |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____                                                          | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1-51 are presently pending. Claims 1-16 and 28-51 are withdrawn from further consideration for the reasons of record. Claims 17-27 are currently under examination.

#### ***Response to Amendment***

##### ***Claim Rejections - 35 USC § 112***

3. The rejection of claims 17-27 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement, is withdrawn in response to Applicant's amendment to the claims.

#### ***Response to Arguments***

##### ***Claim Rejections - 35 USC § 103***

4. Claims 17-27 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Ruoslahti et al. for the reasons of record.
5. Applicant's arguments filed 1-29-08 have been fully considered but they are not persuasive. Applicants traversed the instant rejection on the grounds that Ruoslahti et al. would not lead a person of ordinary skill in the art to have a reasonable expectation of success of the claimed invention. According to Applicants Ruoslahti describes a decorin composition that reduces scarring in a wound by reducing extracellular matrix accumulation. Moreover, according to Applicants the biochemical process taught in this reference is entirely different from the processes recited in instant claims 17 or 23.

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6. Applicant's statements are contrary to the specification as filed which clearly state that: "[0076] In addition, because decorin production by fibroblasts appears to diminish with age and photodamage, and because lack of decorin in skin is associated with decreased tensile strength and skin fragility, several patents exist that specifically mention decorin, but not other SLRPs, in the context of preventing or treating skin aging. For instance boosting decorin synthesis in skin by topical application of conjugated linoleic acid, petroselinic acid, and other compounds (U.S. Pat. No. 6,551,602; U.S. Pat. No. 6,455,057; U.S. Pat. No. 6,440,434; U.S. Pat. No. 6,423,325; U.S. Pat. No. 6,287,553; U.S. Pat. No. 6,042,841) or actual use of decorin in cosmetic or dermatologic compositions (U.S. publication No. 20030124152)."

7. To the extent that the instant claims are drawn to a product, the intended use of Applicant's claimed invention does not appear to impart some structural difference between the claimed composition, and the prior art composition. Ruoslahti et al. discloses compositions comprising decorin or a functional equivalent of decorin, to a wound (see page 5, lines 17-26). Functional equivalents of decorin include the following (see page 14, lines 21-28):

Functional equivalents of decorin include modifications of decorin that retain its functional characteristics and molecules that are homologous to decorin, such as biglycan and fibromodulin, for example, 25 that have the similar functional activity of decorin. Modifications can include, for example, the addition of one or more side chains that do not interfere with the functional activity of the decorin core protein.

Additionally, fibromodulin is clearly disclosed as useful in the compositions of Ruoslahti et al., wherein said compositions are used for skin care.

As stated in the prior Office Action, it would have been obvious to the ordinary skilled artisan at the time of the instant invention to modify the teachings of Ruoslahti et al. to design compositions comprising a proteoglycan, such as decorin and fibromodulin, as set forth in the present invention.

8. Claims 17 and 19-22 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Soo et al. for the reasons of record.

9. Applicant's arguments file 1-29-08 have been fully considered but are not persuasive.

10. Applicants traverse the instant rejection on the grounds that Soo et al. fails to teach a composition that includes "an amount of a proteoglycan compound" or "an amount of a cell lysate, extract, or media enriched with a proteoglycan compound" effective for repairing damages to skin by skin inflammation, skin pigmentation, dermal collagen disorganization, or ..."

11. In response to applicant's argument that Soo et al. does not teach "an amount of a proteoglycan compound," use for repairing damages to skin by skin inflammation, pigmentation, dermal collagen disorganization or aging, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

12. Applicant's arguments cannot take the place of evidence that the prior art compositions do not have the same functions as Applicant's claimed compositions comprising a proteoglycan. As stated in the prior Office Action Soo et al. teach that potential strategies for the manipulation of adult wounds into being more "fetal-like" (i.e. wherein healing comprises avoiding scar formation), may include the addition of *fibromodulin* to modulate both TGF- $\beta$  activity and extracellular matrix assembly. The teachings of Soo et al. clearly teach the use of fibromodulin for wound repair without the formation of scar tissue.

***Claim Rejections - 35 USC § 102***

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

14. Claims 17-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Pang et al. (US 20030124152 A1).

15. Pang et al. teach the following see ¶ [0029]: "[A]ccordingly, it is one object of the invention to provide a novel method for effectively treating and preventing skin aging, repairing damaged skin from aging and restoring skin to a more resiliency and youthful appearance through the topical administration of decorin with a suitable carrier or

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vehicle.” Recombinantly expressed human decorin was isolated from the lysate of E. coli cells expressing this proteoglycan, see ¶ [0084].

### ***Conclusion***

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janet L. Epps-Ford whose telephone number is 571-272-0757. The examiner can normally be reached on M-F, 10:00 AM through 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Woitach can be reached on 571-272-0739. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Janet L. Epps-Ford/  
Primary Examiner, Art Unit 1633

*JLE*